



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,324	12/24/2001	Noriyasu Nakamura	P/2856-25	8048

32172 7590 04/07/2005

DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP
1177 AVENUE OF THE AMERICAS (6TH AVENUE)
41 ST FL.
NEW YORK, NY 10036-2714

EXAMINER

CHUNG, JI YONG DAVID

ART UNIT	PAPER NUMBER
----------	--------------

2143

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/026,324	Applicant(s) NAKAMURA, NORIYASU	
	Examiner Ji-Yong D. Chung	Art Unit 2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/24/01, 12/09/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1, 2, and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamzy.

With respect to **claim 1**, Hamzy shows a system comprising:

a communication network [See lines 33-34, column 4];

a wireless base station connected to said communication network [The base station is not shown directly, but it is inherent in a system for a wireless device mentioned from line 62, column 3 to line 5, column 4. The wireless device *must* communicate through a transceiver gateway];

a website, making available image data via said communication network [See lines 10-26 for URL];

a facsimile connectable via a telephone line [See Fig. 5A and lines 10-42, column 8]; and

a portable terminal [See from line 62, column 3 to line 5, column 4 for a wireless device], *connectable to said communication network via said base station, and which, after*

completion of a connection operation with respect to said communication network in response to a user instruction [See lines 3-20, column 6].

Hamzy does not directly illustrate that the portable terminal does the following: *converts said image data made available from said website to data for facsimile communication, and sends said facsimile communication data via the telephone line to said facsimile*. However Hamzy shows that the portable terminal converts said image data made available from said website to data for printer communication and sends printer communication data to the printer via the proxy server. See from line 54, column 6 to line 3, column 7.

Note that phrase “during” or “after the completion of connection operation” in claim 1 (or in the claims that follow) does not matter in terms of limitations, for the following reasons: any wireless communication device always communicates through a data network “while being connected” and after “the process of connecting” (which implies that the device is still connected to the network).

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Hamzy’s URL processing at the client (used for printing services) to FAX services, because (1) Hamzy indicates that his embodiments suited for printing services can be adapted for other network services such as FAX. See lines 12-14, column 8 and (2) Hamzy indicates such client processing improves the performance of the proxy server. See lines 1-3 column 3.

Note that claim 1’s limitations are read with the understanding that fax data is not sent directly from the portable device to the facsimile machine, but through the proxy server.

With respect to **claim 2**, the following limitations have not been discussed.

Art Unit: 2143

a service center, connectable to said communication network, which sends received facsimile communication data to said facsimile via the telephone line [See proxy server in lines 11-42, column 8 for the “service center”].

Hamzy does not directly illustrate that *a portable terminal, connectable to said communication network via said base station, which, during connection to said communication network, in accordance with an instruction from a user, converts said image data made available from said website to facsimile communication data, and sends said facsimile communication data via said communication network to said service center.*

However, Hamzy shows that the portable terminal converts said image data made available from said website to data for printer communication (with instruction from user) and sends printer communication data to the proxy server (“service center”). See from line 54, column 6 to line 3, column 7.

In reference to **claim 8**, its limitations encompass the scope of limitations of claim 1. Therefore, claim 8 is rejected for substantively the same reason as claim 1.

3. **Claims 6 and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamzy in view of Eldridge et al (Eldridge hereinafter).

In reference to **claim 6**, Hamzy does not show but Eldridge shows the following limitations:

a facsimile connectable to said communication network and to a telephone line, which in a case in which a subject of an electronic mail sent thereto is a URL of said website, accesses said website in accordance with said URL, receives said image data from said website, converts said image data to facsimile communication data, and outputs said data [See item 462 of Fig. 4B for FAX connection and see Token Enabled Servers in Fig. 1. See Fig. 6 for Token aware email server. The token-aware email servers transmit URL (or tokens) instead of documents themselves. The system as revealed by Eldridge takes URL and applies desired services (such as FAX)] and

a portable terminal, connectable to said communication network via said base station, which sends a URL of said website selected by a user as a subject of an electronic mail to said facsimile. See from line 47, column 7 to line 52, column 8. A portable terminal (mobile computing device) can request services on a selected token, which is transmitted to the server when requesting a service. Available services include FAX service.

It would have been obvious to one of ordinary skill in the art at the time of the invention to install Eldridge's token-aware feature on the proxy server of Hamzy, along with proper modification to the portable terminal, because as Eldridge points out in lines 56-61, column 7, using document tokens (URL's) minimizes the memory requirements of the mobile computing devices as well as the bandwidth required for transmitting information.

Claim 7 is different from claim 6 in that the email is sent to a service center rather than a facsimile from the portable terminal. However, Eldridge still meets the limitation, because the

cited token enabled servers shown in Fig. 1 can be viewed as a “service center” rather than as part of the facsimile.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claim 3-5 and 9** are ejected under 35 U.S.C. 102(e) as being anticipated by Hamzy.

With respect to **claim 3**, its limitations except the following have been discussed as being shown by Hamzy in reference to claim 1:

a service center, connectable to said communication network, which accesses said website, in accordance with a received URL of said received website, converts image data made available from said website to facsimile communication data, and sends said facsimile communication data to a received telephone number of said facsimile in accordance with the received telephone number of said facsimile [See lines 11-42, column 8 for proxy server that]
and

a portable terminal, connectable to said communication network via said base station, which, after completion of a connection to said communication network, in accordance with an

Art Unit: 2143

instruction from a user, sends a URL of said website and a telephone number of said facsimile to said service center [See lines 11-42, column 8 for the description of information that is sent to the proxy server, including the URL and the phone number. Note that the fax operation can occur while the client is not connected to the website; this depends on the user operation.

Claim 4's limitations have been discussed with respect to claim 3, except as to the timing of the FAX operation. The limitation on connection timing has been discussed with respect to claim 1.

With respect to **claim 5**, its limitations except the following have been discussed as being shown by Hamzy in reference to claims 1-4:

a facsimile connectable to said communication network and to a telephone line, which in a case in which a priority specified URL of said website is sent from a predetermined URL transfer terminal, in accordance with said URL, accesses said website, receives said image data from said website, converts said image data to facsimile communication data, and outputs said data [See proxy server in line 12-42, column 8 and whatever component that the proxy server drives to transmit fax data are taken as "facsimile." The proxy server is the "predetermined URL transfer terminal." The "facsimile" is indirectly connected to the portable terminal via a telephone line and the network] *and*

a portable terminal, connectable to said communication network via said base station, which sends a URL of said website selected by a user to said facsimile via said telephone line. The URL is "sent via" said telephone line from the portable terminal to "facsimile" (the proxy

server and fax data transmitting means).

With respect to **claim 9**, Hamzy shows *server serving as a service center and being connectable to a communication network, which accesses a website on said communication network in accordance with a URL of said website, converts image data made available by said website to facsimile communication data, and sends said facsimile communication data to a facsimile via a telephone line*. See lines 12-42, column 8 for the proxy server.

6. **Claim 10** is ejected under 35 U.S.C. 102(e) as being anticipated by Marx.

With respect to **claim 10**, Nicholas shows *a facsimile connectable to a communication network and to a telephone line, which in a case in which a URL of a website is sent from a pre-specified URL transfer terminal, accesses said website in accordance with said URL, receives image data from said website, and converts said image data to facsimile communication data*. See Fig. 1, items 100 and 102, which correspond to the applicant's fax machine. See from line 47, column 7 to line 10, column 8.

Conclusion

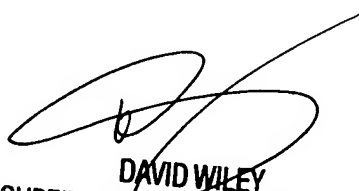
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ji-Yong D. Chung whose telephone number is (571) 272-7988. The examiner can normally be reached on Monday-Friday 9:30-6:00.

Art Unit: 2143

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ji-Yong D. Chung
Patent Examiner
Art Unit: 2143


DAVID WILEY
SUPERVISOR PATENT EXAMINER
TECHNOLOGY CENTER 2100

QPC